

## **REMARKS**

In accordance with the foregoing, claims 1, 3, 5, and 7 have been amended, claims 2, 4, and 6 have been cancelled, and claim 8 has been added. Therefore claims 1, 3, 5, 7, and 8 are pending and under consideration. The Applicant respectfully requests reconsideration of the claims.

### **I. Traversal of the Examiner's reliance on personal knowledge, Official Notice, and common knowledge.**

Throughout the Office action, the Examiner makes assertions without providing an authority or a reference that support the assertions. For example, on page 4, lines 1-6 the Examiner asserts that "a point system . . . and basing a fee on an actual cost, are two well known, hence obvious, elements." Office Action, p. 4, ll. 1-6. Additionally, on page 4 the Examiner asserts "as it is well known to do" and "similar to the pricing scheme/model commonly used with mobile phones." Office Action, p. 4. ll. 10-12.

As the Examiner failed to provide an authority or a reference supporting these assertions, the Applicant assumes that the Examiner is either relying on the Examiner's personal knowledge or is taking Official Notice.

If the Examiner is relying upon the Examiner's personal knowledge, then the Applicant calls for the Examiner to provide an affidavit supporting the Examiner's assertions. *See*, 37 C.F.R. §1.104(d)(2).

If the Examiner is taking Official Notice or relying on common knowledge, then the Applicant traverses the Examiner's assertions. *See* MPEP §2144.04(C)("If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the finding With Adequate Evidence"). In this case, it is submitted that the facts the Examiner asserts are not "capable of such instant an unquestionable demonstration as to defy dispute" or "capable of instant and unquestionable demonstration as being well-known." MPEP § 2144.03(A).

Withdrawal of the rejection based on these unsupported assertions is requested.

### **II. Response to §101 rejection**

The Examiner rejected claims 1, 3, 5, and 7 under 35 U.S.C. §101. This reply responds to this rejection by amending the claims so that they require the use of data processing technologies. And it is asserted that "setting a support fee" as called for in claim 1 is a useful, concrete and tangible result. Withdrawal of the rejection is requested.

**III. Response to rejections based on U.S. Patent No. 6,456,986**

The Examiner rejected claims 1, 3, 5, and 7 under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 6,456,986 ("Boardman"). The Applicant respectfully traverses this rejection.

Claims 1, 3, 5, and 7 are patentable over the prior art for at least two reasons. First, the prior art taken as a whole does not teach or suggest all the features of the claims. Second, neither the teachings of the prior art, the knowledge of persons of ordinary skill in the art, nor the nature of the problem to be solved provide a teaching that would have led one of ordinary skill in the art at the time of the invention to modify the reference.

**A. The prior art does not teach or suggest all the features**

To establish obviousness under §103, the Examiner must consider the claimed invention "as a whole," and the prior art must teach or suggest all of the claim features. *See* MPEP § 2143.03. Claim 1 contains numerous features that are not taught or suggested by the prior art much less where the modification is suggested as desirable.

First, claim 1 recites "obtaining points derived from a job responding to an inquiry from a user from a job-to-point conversion table" and setting a support fee based on them. The Examiner admits that Boardman does not teach this feature. *See* Office Action, p. 3 ("Boardman et al. specifically disclose neither a point system with a point-to-grade conversion table . . ."). Since Boardman fails to teach this feature, the Examiner asserts that the feature is "well known." The Examiner's assertion is incorrect; the feature is not well known in the art today as the Examiner asserts, nor was the feature well known at the time of the invention. As this feature is not taught or suggest by either Boardman or the knowledge that was well known to one of ordinary skill in the art at the time of the invention, the Examiner failed to provide prior art that teaches or suggests this feature.

Second, claim 1 recites "an actual cost for a responding activity to the inquiry from the user" and setting a support fee based on it. The Examiner admits that Boardman does not teach this feature. *See* Office Action, p. 3 ("Boardman et al. specifically disclose neither . . . nor including the actual cost for responding to an inquiry from a user in the determination of the support fee"). As Boardman fails to teach this feature, the Examiner asserts that the feature is "well known." This assertion is also incorrect. This feature is not well known in the art today as the Examiner asserts, nor was the feature well known at the time of the invention. As neither Boardman nor the knowledge that was well known at the time of the invention teaches or

suggests this feature, the Examiner failed to provide prior art that teaches or suggests all the features of claim 1.

Third, claim 1 recites the following,

the points derived are converted to an amount according to the grade of the user by using a point conversion table, in which an amount is set for each grade such that the point derived is converted to a lower amount as the grade becomes higher.

On page 4 of the Office action, the Examiner asserts that this feature is either "found directly in the disclosed method of Boardman et al." or "inherently present" in Boardman as modified by teachings that the Examiner claims are well known or "are of such a minor difference" that its "inclusion would have been self-evident/obvious to one of ordinary skill in the art, at the time of the invention, simply as a matter of design choice." Ex parte Levy, 17 USPQ 2d 1461, 1464 (B.P.A.I. 1990) notes "[T]he examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Thus, the Examiner's assertions are incorrect and not supported by the proper factual foundation. Neither Boardman nor the knowledge that was well known at the time of the invention teach or suggest this feature. Furthermore, the feature is not inherent to Boardman. Contrary to the Examiner's assertions, Boardman teaches nothing comparable to this feature.

Fourth, claim 1 claims "the point conversion table being stored in an evaluating section, and the support fee is computed as a total amount and a total of actual costs for the responding activity to the inquiry of the user." Although the Examiner asserts that this feature is either "found directly in the disclosed method of Boardman et al." or "inherently present" in Boardman as modified by teachings that the Examiner claims are well known or "are of such a minor difference" that its "inclusion would have been self-evident/obvious to one of ordinary skill in the art, at the time of the invention, simply as a matter of design choice," the Examiner provides no support of any of these assertions. Contrary to the Examiner's statements, neither Boardman nor the knowledge that was well known at the time of the invention taken individually or in combination teach or suggest this feature, and the feature is not inherent to Boardman.

Claims 1, 3, 5, and 7 depend upon claim 1. Therefore, claims 1, 3, 5, and 7 are patentable over the prior art at least because the prior art does not teach or suggest all the features of claim 1.

**B. No motivation to combine**

To establish a *prima facie* case of obviousness there must be some teaching in the reference that would have led one of ordinary skill in the art at the time of the invention to combine the references. See MPEP § 2143.01. The Examiner has failed to point to such a teaching in Boardman.

**1. Claim 1**

Regarding claim 1, the Examiner asserts that one of ordinary skill would have been motivated to modify Boardman "in order to increase revenue by enticing customers into purchasing excess support coverage in order to avoid shortfalls, similar to the pricing scheme/model commonly used with mobile phones." Office Action, p. 4. The Examiner's assertion fails to provide a *prima facie* case of obvious for a number of reasons.

First, nothing in the prior art teaches "support coverage." For example, Boardman teaches a system for charging users for making telephone calls and doesn't teach any type of "support coverage." As none of the prior art teaches any "support coverage," one of ordinary skill would certainly not have been motivated to encourage the purchase of "excess support coverage."

Second, although the Examiner refers to a "pricing scheme/model commonly used with mobile phones," nowhere does Boardman teach this feature. Although Boardman teaches a "pricing structure for all fixed wire calls that discounts international calls to Sweden depending on the time the call is made" and "assigning rates to an Event according to the call duration and depending on the week day the call is made," none of these teachings are related to the Examiner's "pricing scheme/model commonly used with mobile phones."

Third, neither the prior art, the knowledge of persons of ordinary skill in the art, nor the nature of the problem to be solved teaches the motivation that the Examiner relies on. The only source teaching the Examiner's motivation is the specification of the current application. Therefore, the Examiner is exercising impermissible hindsight reconstruction.

**2. Claims 1, 3, 5, and 7**

Regarding claims 1, 3, 5, and 7, the Examiner asserts the following, that all of the recited features . . . are of such a minor differences that their inclusion would have been self-evident/obvious to one of ordinary skill in the art, at the time of the invention, simply as a matter of design choice, since their inclusion could be performed readily and easily by any person of ordinary skill in the art, with neither undue

experimentation, nor risk of unexpected results.

Applicant directs the Examiner's attention to the following portions of section 2143.01 of the MPEP:

Fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness

Fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness

MPEP § 2143.01 (capitalization removed).

Asserting that the features would have been obvious "simply as a matter of design choice" and that the "inclusion could be performed readily and easily" is the same as asserting that the invention "is within the capabilities of one of ordinary skill in the art" and that the references "can be combined or modified." As the MPEP clearly explains, these assertion do not establish *prima facie* obviousness.

#### **IV. Newly presented claim 8**

This amendment adds new claim 8. Claim 8 is patentable over the prior art because neither Boardman nor the knowledge that was well-known at the time of the invention taken individually or in combination teach or suggest any type of point system. Furthermore, neither the teachings of the prior art, the knowledge of persons of ordinary skill in the art, nor the nature of the problem to be solved provide a teaching that would have led one of ordinary skill in the art at the time of the invention to modify the references.

#### **CONCLUSION**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

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If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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